

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Group Art Unit: 3621
Examiner: Calvin L. Hewitt II

Application of :	Walter D. BUIST
Serial No. :	10/666,817
Filing Date :	September 17, 2003
Entitled :	SYSTEM AND METHOD FOR MESSAGE COMMUNICATION

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REHEARING AND SUPPORTING BRIEF

Sir:

In accordance with 37 C.F.R. § 41.52, Appellant respectfully submits this request for rehearing of the Decision on Appeal of the Board of Patent Appeals and Interferences, dated December 29, 2008 ("Decision"). For the reasons set forth below, Appellant respectfully requests that the final rejection of Claims 1-24 in the Final Office Action, dated May 19, 2006, be reversed. Applicant believes that no fee is required, but authorizes that any necessary LARGE ENTITY fees be charged to Deposit Account No. 16-2500 of the undersigned.

In the Decision, the Board affirmed the Examiner's rejection of Claims 1-24 under 35 U.S.C. § 102(e), based on the erroneous conclusion U.S. Patent Application

Publication No. U.S. 2004/0030632 (Hausman) inherently anticipated Claims 1-24 on appeal.

Reconsideration is warranted for three fundamental reasons. First, the Board misapprehended Claims 22, 23, and 24 and the legal standard for inherent anticipation. Second, the Board misapprehended Hausman, overlooking that the Hausman system, is incapable, without nonobvious modification, of performing the functions recited in Claims 22, 23, and 24. Third, the Board overlooked that method Claims 1, 7, and 13 could readily be amended to address an argument raised for the first time in the Examiner's Answer, *i.e.*, that those claims could be anticipated solely by "human analysis."

**I. The Board Misapprehended The Claims And
The Legal Standard For Inherent Anticipation.**

"A claim is anticipated only if each and every element of the claim as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

In affirming the Examiner's rejection of Claims 1-24, the Board did not dispute that Hausman did not *explicitly* anticipate Claims 1-24. The Board instead concluded that Hausman *inherently* anticipated those claims. (Decision at 6-9.)

An Examiner can "shift the burden" to an applicant "by showing how a prior art structure substantially corresponds to a claimed structure such that it would be reasonable to presume that the prior art structure would also possess a claimed function employing

an inherency theory.” *Ex Parte Kogure*, Appeal 2007-1854, 2007 WL 2698509, at *3 (Aug. 27, 2007) (reversing examiner’s anticipation rejection based on inherency where the examiner did not articulate how the prior art computer system would be capable of performing the claimed functions “*without modification.*”) (emphasis added) (citing *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). However, the Examiner did not rely on inherent anticipation during prosecution and in briefing the present appeal. Thus, Applicant has not had a fair opportunity to respond to the Board’s inherent anticipation theory.

In *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis in original), the Federal Circuit explained the standard for inherency as follows:

Inherency . . . may not be established by probabilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Because the Board misapprehended the legal standard for inherent anticipation, the Board erred in holding that Claim 22 does not require the recited interpreter to interpret a message communicated in a field delimited communication protocol to have a different meaning from the standard, publicly-known meaning under the filed delimited communication protocol. (Decision at 9 (“Appellant next argues that the claimed translator/encoder devices are further required by the claims to interpret/encode messages intended to have a meaning different from the standard, publicly-known meaning. (Reply

Br. 5,6.) We disagree with Appellant.”.) For the same reason, the Board also erred in holding that Claims 23 and 24¹ do not require the recited encoder in those claims to encode a message in a field delimited protocol to have a meaning different from the standard, publicly-known meaning. (*Id.*)

The Board failed to give the functions recited in the claims on appeal patentable weight and failed to determine that the system of Hausman was capable of performing those functions *without modification*. *Ex Parte Kogure*, 2007 WL 2698509, at *3.

II. The Board Erred In Holding That Hausman Inherently Anticipated The Claims On Appeal Because The Hausman System Is Not Capable Of Performing The Claimed Functions Without Modification.

The Board erred in overlooking that Hausman does not mention in words, let alone describe the concepts, of the functions performed by the interpreter and encoder recited in Claims 22, 23, and 24. Even if Hausman could be viewed as disclosing the use of an interpreter and encoder, the Board erred in overlooking that the Hausman system is not *capable* of performing the claimed functions *without modification* and therefore cannot inherently anticipate those claims.

The Board found that “Hausman discloses an interpreter in the form of a currency translator which interprets the desired value of money an orderer wishes to spend in one currency and translates that value into another country’s currency (FF6). The currency translator device in Hausman also includes an encoder which encodes a value entered as either a percentage or float to translate the same value into foreign currency. (FF6).”

¹ The Decision also overlooked (did not address) Applicant’s arguments with regard to Claim 24.

(Decision at 8.) The Board concluded that the “currency translator apparatus in Hausman performs automatic calculations (FF6) and is thus *capable of being programmed* to encode and interpret the values which it messages, e.g. multiply every value entered by 10 (encode) and divide the received value by 10 (interpret).” (*Id.* (emphasis added).)

First, the Board overlooked that *Ex Parte Kogure* holds that inherent anticipation requires more than the mere fact the system of Hausman is *capable of being programmed differently* than as described in Hausman to perform the functions recited in Claims 22, 23, and 24. The *Ex Parte Kogure* Board reversed a rejection based on inherent anticipation where “the examiner ha[d] not reasonably articulated how the analyzer (programmed computer) described in [the prior art reference] would be capable of carrying out the claimed processing and warning function that the claimed device is structured to perform *without modification* to the system of [the prior art reference].” *Id.*, 2007 WL 2698509, at *3 (emphasis added). Here, the Board has not pointed to anything disclosed in Hausman that establishes that the Hausman system is capable, *without modification*, of performing the claimed functions of interpreting and encoding messages communicated in a field delimited communication protocol to have meanings different than the standard, publicly-known meaning under the field delimited communication protocol that the devices recited in Claims 22, 23, and 24 are programmed to perform.

Second, the Board erred by conflating the concept of currency translation, which is described in Hausman, with the concepts of encoding and interpreting messages communicated in field delimited communication protocols to have meanings different

than the standard, publicly-known protocol meaning, which is *not* disclosed in Hausman. Performing the automatic calculations necessary to translate the value of money in one currency to another is translation not interpretation. Translation is turning from one language into another or, as in the case of Hausman, expressing the value of one currency in another currency by applying an exchange rate. Interpretation, by contrast, is giving or providing meaning, or construing or understanding a meaning, in a particular way.

Applicant's claimed devices are uniquely configured to perform the functions of interpreting and encoding messages communicated in a field delimited communication protocol to be interpreted to have coded meanings that are different than their standard, publicly-known meanings under the field delimited communication protocol. Those functions are not – contrary to the Board's Decision – simply multiplying and dividing by 10 (or some other factor). (Decision at 9.) The devices of Claims 22, 23, and 24 are structurally different from the devices of Hausman, which are not programmed to perform those functions and could not perform the recited functions without being specifically re-programmed to perform those functions.²

² *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997), cited in the Decision, is readily distinguished. In *Schreiber*, the prior art mechanical device was structurally the same as the claimed device, and the Federal Circuit found that recitation of a new use for an old product does not make a claim to the old product patentable. Here, by contrast, the devices are new devices specifically and uniquely programmed to perform functions that the prior art device could not perform without having different programming. Taken to its extreme, the Board's flawed reasoning would hold that computer-implemented inventions claimed in functional terms could not be allowed if a prior art computer could have been programmed differently to perform the recited functions. That simply is not the law.

III. The Board Has Overlooked That Claims 1, 7, 13 And Their Dependent Claims Could Readily Be Amended To Recite That The Encoding And Interpreting Steps Be Performed By A Computer.

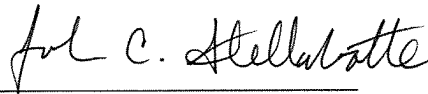
The Board has overlooked that the Claims 1, 7, 13, and the other dependent method claims readily could be amended to specifically claim that the encoding and interpreting steps are performed using a computing device as, described in the specification. Such an amendment would preclude a finding that those method claims could “be accomplished by human analysis” to anticipate those claims. (Decision at 7.) Because this argument was made for the first time in the Examiner’s Answer, there was no reason to make such an amendment before. However, applicant is willing to make such an amendment now.

IV. Conclusion

For the reasons set forth herein and in Appellant's Amended Brief on Appeal and Reply Brief, Appellant respectfully requests that the Board grant the foregoing request for reconsideration. Appellant respectfully requests that the final rejection of Claims 1-24, dated May 19, 2006, be reversed and remanded. Appellant's undersigned attorney may be reached at (212) 969-3413 or by facsimile at (212) 969-2900. Please continue to direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP
Attorney for Applicant

By 
John C. Stellabotte
Reg. No. 47,969

Date: February 26, 2009

PROSKAUER ROSE LLP
Patent Department
1585 Broadway
New York, NY 10036-8299
Telephone: (212) 969-3000